



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,350	10/16/2001	Catherine L. Amann	3013/68	6710

5514 7590 11/27/2006

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

LIU, I JUNG

ART UNIT PAPER NUMBER

3691

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,350

Applicant(s)

AMANN ET AL.

Examiner

Marissa Liu

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/16/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 4, 15, and 17 are rejected because the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product. The claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 25 is rejected under 35 U.S.C. 102(b) as being unpatentable by Schutzer, U.S. Patent. No. 6,292,789 B1 (PTO-892 reference A).
3. As per claim 25, Schutzer teaches a computer readable media storing (see column 9, lines 38-40 and column 12, lines 14-17) request translation software operative to receive a payment request (see column 4, lines 56-63) formatted in a native format (see column 9, lines 36-42, where "standard format" is equivalent of "native format") of a computer network and to translate the payment request into a native format (see column 9, lines 36-42, where "standard format" is equivalent of "native format") of an ATM network (see column 9, lines 36-42 and column 1, lines 48-56).

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schutzer, U.S. Patent. No. 6,292,789 B1 (PTO-892 reference A), in view of Braun et al., U.S. Patent No. 4,321,672 (PTO-892 reference B).
3. As per claim 1, Schutzer teaches a system for executing a cash payment from a computer network, the system comprising:

a payor computing device for transmitting a payment request over the computer network to a P2P server, the P2P server operative to receive the payment request (see column 4, lines 56-63) and debit a financial instrument specified by a user of the payor computing device (see column 1, lines 48-56 and 66-67, column 2, lines 1-2), the payor computing device and P2P server communicating according to a native format (see column 9, lines 36-42, where “standard format” is equivalent of “native format”) of the P2P server, request translation software operative (see abstract, column 27, lines 7-35) to receive the payment request and translate the request into the native format (see column 9, lines 36-42, where “standard format” is equivalent of “native format”) of an ATM control server (see column 9, lines 36-42 and column 1, lines 48-56). Schutzer does not teach the following:

Art Unit: 3691

the ATM control server operative to generate and transmit payment instructions and a PIN code, thereby enabling an ATM to dispense the payment upon receipt of the PIN code;

Braun et al. teaches the following:

the ATM control server operative to generate and transmit payment instructions (see Fig. 6) and a PIN code (see Fig 4), thereby enabling an ATM to dispense the payment (see Figure 2) upon receipt of the PIN code (see column 11, lines 50-68).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions and a PIN code feature to a payor computing device of Schutzer because Braun et al. teaches that adding the to generate and transmit payment instructions and a PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

4. As per claim 2, Schutzer and Braun et al. teach a system of claim 1 described above. Braun et al. further teach wherein the ATM (see Figure 3) receives payment instructions (see column 6, lines 60-63) from the ATM control server (see Figures 4, column 18, lines 72-68).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions feature of Braun et al. to a payor computing device of Schutzer because Braun et al. teaches that adding the to generate and transmit payment instructions helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

Art Unit: 3691

5. As per claim 3, Schutzer and Braun et al. teach a system of claim 1 described above.

Schutzer further teaches system wherein the request translation software is operative to translate the payment request into a request formatted (see abstract, column 27, lines 7-35) in accordance with a Z-Cash standard (see column 1, lines 14-18, where “filed of computerized bill presentment and more particularly to the electronic delivery of a bill from any biller to any consumer” is equivalent of “Z-Cash”).

6. As per claim 4, Schutzer and Braun et al. teach a system of claim 1 described above. Schutzer further teaches system wherein the request translation software is operative to translate (see abstract, column 27, lines 7-35) the payment request into multiple native formats (see column 9, lines 36-42, where “standard format” is equivalent of “native format) of a plurality of disparate ATM control servers (see column 9, lines 36-42 and column 1, lines 48-56).

7. As per claim 5, Schutzer and Braun et al. teach a system of claim 4 described above. Schutzer further teaches wherein one of the multiple native formats is the Z-Cash standard (see column 1, lines 14-18, where “filed of computerized bill presentment and more particularly to the electronic delivery of a bill from any biller to any consumer” is equivalent of “Z-Cash”).

8. As per claim 6, Schutzer and Braun et al. teach a system of claim 1 described above. Braun et al. further teaches a system wherein the ATM generates and transmits a response that it has received the payment instructions (see column 19, lines 7-24 of Braun et al.).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions feature to a

Art Unit: 3691

payor computing device of Schutzer because Braun et al. teaches that adding the to generate and transmit payment instructions helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

9. As per claim 7, Schutzer and Braun et al. teach a system of claim 6 described above. Schutzer further teach wherein the request translation software is operative to receive a response from the ATM control server (see column 1, lines 48-56 and column 9, lines 36-42), to convert the response into a format that is native (see column 9, lines 36-42, where “standard format” is equivalent of “native format), to that utilized by the P2P sever, and transmit the response to the P2P server (column 4, lines 56-63, column 12, lines 14-25).

Schutzer does not teach:

ATM has received the payment instructions.

Braun et al. teaches ATM has received the payment instructions (see Fig 3 and 6 of Braun et al.)

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions feature to a payor computing device of Schutzer because Braun et al. teaches that adding the to generate and transmit payment instructions feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

10. As per claim 8, Schutzer and Braun et al. teach a system of claim 7 described above. Schutzer further teach wherein the request translation software translates (see column 27, lines 7-

Art Unit: 3691

35) the response into a format that is native (see column 9, lines 36-42) to that utilized by the P2P server (see abstract and column 12, lines 14-17).

11. As per claim 13, Schutzer and Braun et al. teach a method for executing a cash payment via a computer network, the method comprising:

Schutzer teaches transmitting a payment request from a payor computing device over the computer network to a P2P server, the P2P server operative to receive and process the payment request by debiting a financial instrument specified by the user of the payor computing device (see column 27, lines 2-35), the payor computing device and P2P server in communication according to a native format (see column 9, lines 36-42) of the P2P server; executing request translation software to receive the payment request and translate the request into a native format of an ATM control server (see column 1, lines 48-56, column 9, lines 36-42 and column 27, lines 1-35).

Schutzer does not teaches the following:

the ATM control server operative to generate and transmit payment instructions and a PIN code; and sending payment instructions to an ATM.

Braun et al. teaches the following:

the ATM control server operative to generate and transmit payment instructions and a PIN code; and sending payment instructions to an ATM (see Figures 2, 3, 4 and 6, abstract, column 11, lines 50-68, column 12, lines 1-12 and lines 25-33);

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions and a PIN code feature to a payor computing device of Schutzer because Braun et al. teaches that adding the to



Art Unit: 3691

generate and transmit payment instructions and a PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

12. As per claim 14, Schutzer and Braun et al. teach a method of claim 13 described above. Braun et al. further teaches transmitting the payment instructions from the ATM control server to the ATM (see Figures 3 and 6, column 9, lines 36-42).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions feature to a payor computing device of Schutzer because Braun et al. teaches that adding the to generate and transmit payment instructions feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

13. As per claim 15, Schutzer and Braun et al. teach a method of claim 13 described above. Schutzer further teaches a method comprising translating the payment request (see column 4, lines 55-63) into a request formatted in accordance with a Z-Cash standard (see abstract and column 1, lines 14-18, where “filed of computerized bill presentment and more particularly to the electronic delivery of a bill from any biller to any consumer” is equivalent of “Z-Cash”).

14. As per claim 16, Schutzer and Braun et al. teach a method of claim 13 described above. Schutzer further teaches method wherein translating the payment request (see column 4, lines 55-63) into the native format of one of multiple native formats of a plurality of disparate ATM control servers (see column 9, lines 36-48 and column 27, lines 1-35).

Art Unit: 3691

15. As per claim 17, Schutzer and Braun et al. teach a method of claim 16 described above. Schutzer further teaches the method wherein the step of translating into the native format of one of multiple native formats (see column 9, lines 36-42 and column 27, lines 1-35) comprises translating into a format in accordance with the Z-Cash standard (see column 1, lines 14-18, where “filed of computerized bill presentment and more particularly to the electronic delivery of a bill from any biller to any consumer” is equivalent of “Z-Cash”).

16. As per claim 18, Schutzer and Braun et al. teach a method of claim 13 described above. Braun et al. further teaches a method comprising: generating and transmitting a response at the ATM that the payment instructions have been received (see column 19, lines 7-24 of Braun et al.).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions feature to a payor computing device of Schutzer because Braun et al. teaches that adding the to generate and transmit payment instructions feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

17. Claims 9-12 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schutzer, U.S. Pub. No. 6,292,789 B1 (PTO-892 reference A) and Braun et al., U.S. Patent No. 4,321,672 (PTO-892 reference B) as applied to claim 7 above, and further in view of Kisor, U.S. Patent No. 6,098,091 (PTO-892 reference C).

Art Unit: 3691

18. As per claim 9, Schutzer and Braun et al. teach a system of claim 7 above. Kisor further teaches wherein the P2P sever transmits the response to a payee computing device (see abstract of Kisor, where “transmit status report” is equivalent of “transmit the response”).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add transmitting the response feature of Kisor to a combined payor computing device of Schutzer and Braun et al. because Schutzer teaches that adding to transmit the response feature helps reducing the time, the labor, the documents used, and the expense of such processing (see column 2, lines 13-26 of Schutzer).

19. As per claim 10, Schutzer, Kisor and Braun et al teach a system of claim 9 described above. Braun et al. further teaches wherein the response from the ATM control server comprises the PIN code (see column 32, lines 42-48 and column 34, lines 7-10, where “computer system” is equivalent of “server”).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the PIN code feature to a combined payor computing device of Schutzer, Kisor and Braun et al. because Braun et al. teaches that adding the PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

20. As per claim 11, Schutzer, Kisor and Braun et al. teach a system of claim 10 described above. Braun et al. further teaches the PIN code is transmitted to the payor computing device (see column 11, lines 50-59, where “ATM” is equivalent of “computing device” of Braun et al.).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the PIN code feature to a combined payor computing device of Schutzer, Kisor and Braun et al. because Braun et al. teaches that adding the PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

21. As per claim 12, Schutzer, Kisor and Braun et al. teach a system of claim 11 described above. Braun et al. further teaches wherein the ATM dispenses an amount specified by the payment instructions in response to the PIN code (see column 11, lines 50-68, column 12, lines 1-29, and column 32, lines 42-48).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting payment instructions feature to a combined payor computing device of Schutzer, Kisor and Braun et al. because Braun et al. teaches that adding the to generate and transmit payment instructions feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

22. As per claim 19, Schutzer, Kisor and Braun et al. teach a method of claim 18 described above. Schutzer further teaches receiving a response at the ATM control server from the ATM that the payment instructions have been received (see Figure 3 and 6); converting the response into a format that is native (column 9, lines 36-42 and column 27, lines 1-35) to that utilized by the P2P server; (see column 1, lines 48-67, column 4, lines 56-63, and column 12, lines 14-17).

Schutzer does not teach transmitting the response to the P2P server;

Art Unit: 3691

Kisor teaches transmitting the response to the P2P server (see abstract of Kisor, where “transmit status report” is equivalent of “transmit the response”).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add transmitting the response feature of Kisor to a combined payor computing device of Schutzer and Braun et al., because Schutzer teaches that adding to transmit the response feature helps reducing the time, the labor, the documents used, and the expense of such processing (see column 2, lines 13-26 of Schutzer).

23. As per claim 20, Schutzer, Kisor and Braun et al. teach a method of claim 19 described above. Schutzer further teach translating the request into a format that is native to that utilized by the P2P server by the request translation software (see column 27, lines 1-35 and column 9, lines 36-42, where “standard format” is equivalent of “native format”).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting PIN code feature to a combined payor computing device of Schutzer, Kisor and Braun et al., because Braun et al. teaches that adding the to generate and PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

24. As per claim 21, Schutzer, Kisor and Braun et al. teach a system of claim 19 above. Kisor further teaches transmitting the response to a payee computing device (see abstract of Kisor, where “transmit status report” is equivalent of “transmit the response”).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting PIN code feature to a combined payor

Art Unit: 3691

computing device of Schutzer, Kisor and Braun et al., because Braun et al. teaches that adding the to generate and PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

25. As per claim 22, Schutzer, Kisor and Braun et al teaches a system of claim 21 described above. Braun et al. further teaches wherein the response from the ATM control server comprises the PIN code (see column 32, lines 42-48 and column 34, lines 7-10, where “computer system” is equivalent of “server”).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting PIN code feature to a combined payor computing device of Schutzer, Kisor and Braun et al., because Braun et al. teaches that adding the to generate and PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

26. As per claim 23, Schutzer, Kisor and Braun et al. teaches a system of claim 22 described above. Braun et al. further teaches transmitting the PIN code to the payor computing device (see column 11, lines 50-59, where “ATM” is equivalent of “computing device” of Braun et al.).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting PIN code feature to a combined payor computing device of Schutzer, Kisor, and Braun et al., because Braun et al. teaches that adding the to generate and PIN code feature helps essentials of the transaction can be transmitted

Art Unit: 3691

efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

27. As per claim 24, Schutzer and Braun et al. teach a system of claim 23 described above. Braun et al. further teaches wherein the ATM dispenses an amount (see column 12, lines 1-29) specified by the payment instructions (see Figure 3 and 6) in response to the PIN code (see column 11, lines 50-68).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add generating and transmitting PIN code feature to a combined payor computing device of Schutzer, Kisor, and Braun et al., because Braun et al. teaches that adding the to generate and PIN code feature helps essentials of the transaction can be transmitted efficiently to the financial institution, without complex input procedures (see column 3, lines 32-45 of Braun et al.).

### ***Conclusion***

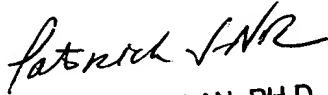
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Liu whose telephone number is 571-270-1370. The examiner can normally be reached on First Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick James Nolan can be reached on 571-270-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

\*\*\*

  
PATRICK J. NOLAN, PH.D.  
SUPERVISORY PATENT EXAMINER  
11/16/06